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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,958	01/25/2001	Hans Heid	(Z) 98017 P US	7016
7590 02/10/2006			EXAMINER	
M. Robert Kestenbaum 11011 Bermuda Dunes NE Albuquerque, NM 87111			DEXTER, CLARK F	
			ART UNIT	PAPER NUMBER
			3724	
DATE MAILED: 02/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/770,958	HEID, HANS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Clark F. Dexter	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 3, 2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. Claims 2-7 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, line 15, the recitation "between the maximum section thickness which can be set on the microtome and 2 mm" is vague and indefinite as to what range is being set forth, particularly as to whether the range is less than or equal to 2 mm, or greater than or equal to 2 mm (i.e., it is not clear as to what value is represented by the recitation "the maximum thickness which can be set on the microtome"); in lines 17-18, the recitation "a small gap" is vague and indefinite as to whether it refers to the gap previously set forth or to another such gap, and it is suggested in line 14 to insert --first-- before "gap", and in lines 18 and 22, to change "small" to --second-- or the like.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4, 6, 7, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, pn 5,784,936.

King discloses a knife assembly (e.g., in Fig. 1) with almost every structural limitation of the claimed invention including:

a knife (e.g., 44, 48) having a cutting edge and a back face,  
a knife carrier (e.g., 46 and the structure to which 46 is mounted),  
a specimen holder (e.g., 34), viewed from the standpoint of the operator, being disposed behind the cutting plane (e.g., "behind" being interpreted as above in Fig. 1), while the knife and knife carrier are disposed in front of said cutting plane (e.g., "in front of" being interpreted as below in Fig. 1) such that a cut section will remain lying on the freely accessible back face of the knife for section removal, and

a blade guard comprising a plate (e.g., 40), said blade guard having an operating position,

wherein said plate is arranged in a way that performance of cutting operations and section removal takes place even with the plate situated in its operating position by an arrangement of the plate in its operating position parallel to the cutting plane, on the side of the knife carrier, and spaced from the cutting plane by a (first) gap, and at the

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same time the plate faces the cutting edge of the knife with a (second) gap in the cutting direction between the cutting edge of the knife and the edge of the plate toward the knife with a maximum width chosen such that the joint of a person's finger cannot come into contact with the cutting edge of the knife - in order to prevent unintentional gripping of the knife edge - but sufficient for a section taken from the specimen to be able to slide through said small gap between the plate and the back face of the knife.

King lacks a disclosure of the specific sizes of the first and second gaps.

However, to provide first and second gaps within the claimed ranges would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art. Further, it is been held that, absent a showing of superior results, a mere change in size would be within the skill level of one having ordinary skill in the art.

In the alternative, if it is argued that King does not meet the limitation "which is on the side of the operator", it would have been obvious to one having ordinary skill in the art to arrange the device disclosed in King in any variety of orientations for various known benefits including to correspond to design arrangements in a manufacturing line and/or plant, or to improve cutting conditions during cutting of some types of work pieces. For example, one having ordinary skill in the art would realize that the cutting device, per se, of King would operate equally well in several orientations, particularly rotated 90 degrees in either direction about an axis defining the path work piece. That is, the cutting device could be rotated 90 degrees with respect to the drawing and to the conveyor. The conveyor would obviously remain in its same orientation so that it could

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continue to receive and convey cut work pieces. Such a modification would provide various well known benefits including reducing the pressure in the cutting area, particularly due to the weight of the work piece on the abutting surface, to provide improved cutting conditions for some types of work pieces. Therefore, it would have been obvious to one having ordinary skill in the art to provide an orientation of the cutting device of King as claimed for the well known benefits including that described above.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, pn 5,784,936 as applied to claim 1 above, and further in view of Ducourneau, pn 3,515,192.

King discloses a knife holder (e.g., in Fig. 1) with almost every structural limitation of the claimed invention as described above but lacks the plate being transparent. However, it is old and well known in the art to make support and/or guide components from any one of various types of known materials including transparent materials. Transparent materials provide the obvious and well known benefits of being easily inspected for cleanliness and easily cleaned (e.g., glass), and also provides well known benefits including facilitating inspection of other parts of the machine (e.g., those below the component) to determine if cleaning or other maintenance is required. Ducourneau discloses one example of such a guide component. Therefore, it would have been obvious to one having ordinary skill in the art to make the plate of King from a transparent material for the well known benefits including those described above.

6. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, pn 5,784,936 as applied to claim 1 above, and further in view of Kuchler, pn 5,477,760.

King discloses a knife holder (e.g., in Fig. 1) with almost every structural limitation of the claimed invention as described above but lacks the plate being coupled to a switch. However, switches as claimed are old and well known in the art and provide various known benefits including indicating the position of an adjustable component; or example, indicating whether the adjustable component has reached a position of significance (such as a "0" adjustment point, or a maximum point of adjustment such as a limit switch). As one example, Kuchler discloses such a switch for setting slice thickness and for switching-on the machine controller. Therefore, it would have been obvious to one having ordinary skill in the art to provide a switch on the device of King for the well known benefits including those described above; for example, to remotely adjust the adjustable plate of King and/or to actuate a machine controller for King.

### ***Response to Arguments***

7. Applicant's arguments filed November 3, 2005 have been fully considered but they are not persuasive.

In applicant's arguments on pages 5-6 of the response, applicant appears to be taking the position that the plate of King does not perform the same function as the plate of the present invention; that is, it does not act as a finger guard. First, it is noted that

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there appears to be no support in King for such an argument. Second, it is respectfully submitted that the Examiner's position is not that the plate of King and that of the present invention are used for the same purpose. Rather, the Examiner's position is that the prior art teaches and/or suggests all of the structure of the claimed invention. Further, it is noted that the invention set forth in the active claims is directed to a knife assembly, and there is no support regarding the type of access a user would have to the knife once the knife assembly is made to be part of a microtome; that is, Figure 1 does not show the work feed structure, and Figure 2 only shows part of the work feed structure but does not show the entire microtome. Further, when isolating the knife assembly of King (which is all that is being claimed in the present invention), King teaches and/or suggests all of the claimed structure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
January 24, 2006